

### Remarks

The Office Action and the references cited therein have been carefully reviewed. The following remarks herein are considered to be responsive thereto. Claims 1 and 3-11 remain in this application. Claim 1 is presently amended by this amendment and Claim 2 has been cancelled by this amendment.

The Examiner rejected claims 1, 2, 6, 7 and 11 under 35 U.S.C. §102 (b) as being anticipated by the prior art as recited in the Applicants' application (AAPA). The Examiner further rejected claims 1, 6 and 11 under 35 U.S.C. §102(e) as being anticipated by US Patent No. 6,473,130 issued to Kim (Kim).

Claims 2 and 7-11 were rejected by the Examiner under 35 U.S.C. §103 (a) as being unpatentable over Kim and AAPA in view of US Patent Application Publication No. 2002/0069411 A1 issued to Rainville, et al. (Rainville). Claims 3-5 were rejected by the Examiner under 35 U.S.C. §103 (a) as being unpatentable over Kim in view of AAPA.

In response, Applicants have amended independent claim 1 of the present application. Applicants respectfully submit that independent claim 1 is patentably distinguished over the cited references and is allowable and that claims 3-11 are allowable at least because they depend from an allowable base claim.

The patent to Kim discloses a method and apparatus for displaying sub-pictures. The state of a main picture is detected from a picture signal. A controller is utilized to control the operation of a signal processor based upon the detected main picture state so that the sub-picture is discerned from the main picture. The sub-picture is *distinctively discerned* from the main picture irrespective of the picture state of the main picture by

varying the display state (brightness or dimness) of the sub-picture according to the spatial complexity *or* the temporal movement degree of the main picture. “However, only one of the spatial complexity and the temporal movement degree of the main picture can be used for discerning the sub-picture from the main picture.” Col. 3, lines 65-67.

Kim further discloses that the “sub-picture display apparatus provides an effect capable of distinctively displaying the sub-picture more definitely and clearly, by thickening the boundary portion of the sub-picture and varying the brightness of the sub-picture to become brighter.” Col. 4, lines 1-6.

In contrast, the publication of Rainville discloses a system for the enhanced display of World Wide Web pages on a television. Rainville discloses that a viewer is provided with the capability to control the transparency of a PIP image. The PIP image is controlled in a manner such that the part of the PIP image that may normally cover up an important part of the background Web page image is made transparent so that the user can view the background Web page image through the transparent PIP image. Paragraph 8.

Claim 1 of the present application is being amended for clarification purposes to more accurately and definitively set forth the invention. Claim 1 has been amended to particularly set forth:

a processor operatively coupled to the display and configured to receive a first video data stream for the primary image, to receive a second video data stream for the PIP, and to change a PIP display characteristic in response to a at least one characteristic present in the primary image, wherein the PIP display characteristic is at

least one of a position of the PIP on the display, a display size of the PIP, and a transparency of the PIP.

The AAPA as cited by the Examiner as comprising a processor, wherein the processor “automatically repositions the PIP in response to detected motion between one [frame] of the video image and the next frame.” However, the prior art system further comprises deficiencies in that there may be many portions of a display screen that have motion, yet the prior art has no procedure for discerning which portions of a display are more or less important.

Further, video segments may have dialogue portions wherein there is little or no motion, and yet these portions of the video segment may comprise a primary area of interest in the video segment. In the prior art systems, the motion in a background portion of the video segment may cause the PIP to be repositioned over other portions that may not have as much relative motion but may still be of importance.

Additionally, the prior art as cited does not disclose a processor that changes the display characteristics of a PIP that correspond to the display size of the PIP or the transparency of the PIP.

Similarly, the Examiner cited Kim for disclosing a processor that comprises a “detector 12, controller 14 and signal processor 13 which vary the brightness of the PIP image based upon the spatial complexity or temporal movement of the main picture signal.” However, Kim also fails to disclose a processor that changes the display characteristics of a PIP that correspond to the position of the PIP on the display, the size of the PIP or the transparency of the PIP. Kim is limited in scope to a processing system

that varies the brightness of a PIP image based upon characteristics that are present in a primary image.

Therefore, it is respectfully submitted that claim 1 is allowable for at least the given reasons. Further, claims 3-11, which depend from claim 1, are allowable therewith at least because they depend from an allowable base claim. Consequently, the Examiner is respectfully requested to withdraw the rejection of claims 3-11.

As per claims 7-11 The Examiner states “Kim does not specifically address the position, display size or transparency of the PIP.” Further, the Examiner states “it would have been obvious...to modify Kim and AAPA, which change position and/or size of PIP based on the main picture signal...by also rendering the PIP transparent as done by Rainville in order to provide the user the ability to see the entire background image when the changing of position and/or size of the PIP does not adequately display the main picture signal.”

However, as mentioned above, the patent to Kim discloses that a sub-picture is *distinctively discerned* from the main picture irrespective of the picture state of the main picture by varying the display state (brightness or dimness) of the sub-picture according to the spatial complexity *or* the temporal movement degree of the main picture. Further, the “sub-picture display apparatus provides an effect capable of distinctively displaying the sub-picture more *definitely and clearly*, by thickening the boundary portion of the sub-picture and varying the brightness of the sub-picture to become brighter.” Col. 4, lines 1-6.

Additionally, Rainville discloses that a viewer is provided with the capability to control the transparency of a PIP image. The PIP image is controlled in a manner such

that the part of the PIP image that may normally cover up an important part of the background Web page image is made transparent so that the user can view the background Web page image through the transparent PIP image.

It can be properly ascertained from the individual disclosures that the inventions of the two patents teach away from each other. The objective of Kim is to provide a PIP that is more visible regardless of the state of the background image so that a viewer may always be able to properly view the PIP image. Conversely, the objective of Rainville is to provide a PIP that can be made transparent in order to enable a user to more clearly view a background image. One cannot determine that there is proper motivation to combine the two inventions when they clearly have contradictory purposes.

The Federal Circuit has dealt with what is required to show a motivation to combine references under 35 U.S.C. § 103(a):

[R]ather than pointing to specific information in Holiday or Shapiro that suggest the combination..., the Board instead described in detail the similarities between the Holiday and Shapiro references and the claimed invention, noting that one reference or the other-in combination with each other... described all of the limitations of the pending claims. Nowhere does the Board particularly identify any suggestion, teaching, or motivation to combine the ... references, nor does the Board make specific-or even inferential-findings concerning the identification of the relevant art, the level of ordinary skill in the art, the nature of the problem to be solved, or any factual findings that might serve to support a proper obviousness analysis.

*In re Dembiczak*, 50 USPQ2d 1614, 1618 (Fed. Cir., April 28, 1999) (citations omitted).

Thus, from *In re Dembiczak* it is clear that the Federal Circuit requires a specific identification of a suggestion, motivation, or teaching why one of ordinary skill in the art

would have been motivated to select the references and combine them. In this instance the Examiner has not done this.

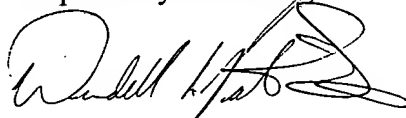
Thus, Applicant respectfully submits that the Examiner has used impermissible hindsight to reject claims 7-11 under 35 U.S.C. 103(a). To prevent the use of hindsight based on the invention to defeat patentability of the invention, the Examiner is required to show a motivation to combine the references that create the case of obviousness.

Applicant respectfully submits that the Examiner has not met this burden.

In light of the Examiner's lack of specificity with regard to the motivation to combine the cited references, the applicant respectfully submits that the rejections for obviousness of claims 7-11 under 35 U.S.C. 103(a) lack the requisite motivation and must be withdrawn.

In view of the above, it is respectfully submitted that this application is in condition for allowance. Accordingly, it is respectfully requested that this application be allowed and a Notice of Allowance issued. If the Examiner believes that a telephone conference with Applicant's attorneys would be advantageous to the disposition of this case, the Examiner is requested to telephone the undersigned.

Respectfully submitted,



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